

REMARKS

I. Interview Summary

Examiner Ly is thanked for the courtesies extended to the Applicant's attorney during a telephone interview on October 29, 2004. During this interview, the Applicant's attorney addressed the claimed invention, the differences between the claimed invention and the cited art, and the rejections over the cited art.

The Applicant's attorney stated that the second Office Action of September 20, 2004 did not address the highlighted claimed limitation “....so that each recipient data set includes only data sets associated with each corresponding recipient account.” The Applicant's attorney also noted that the highlighted limitation was not addressed in the first Office Action, noted that this point was raised in the reply filed on June 14, 2004 at pages 14-15, and submitted that the rejections of claims 1, 11 and 20 could not stand for the failure to establish that the cited art disclosed or suggested this limitation. Accordingly, these rejections failed to establish a prima facie case of obviousness and the claims are presently in condition for allowance.

Additionally, the Applicant's attorney noted that claim 26 recites a transaction file storing a transaction history of the distribution of data sets, and that the Office Action stated on page 9 that the graphics file disclosed in Sherman meets this limitation. The Applicant's attorney referred to pages 18-19 of the reply of June 14, 2004, and reiterated that a graphics file could not be construed to disclose, teach or suggest the claimed transaction history file. For this additional reason, the Applicant's attorney respectfully submitted that the rejections of these claims in the second Office Action should be withdrawn and a notice of allowance be issued.

Finally, the Applicant's attorney submitted that the claims were allowable over the cited art of record for the arguments set forth in the reply filed on June 14, 2004, and which were not rebutted in the second Office Action. For these reasons, the Applicant's attorney respectfully submitted that the rejections of the second Office Action should be withdrawn and a notice of allowance be issued.

In reply, the Examiner suggested that claim 1 be amended to read “data sets associated with each corresponding recipient account associated with the class,” and that

the remaining independent claims be likewise amended. The Applicant's attorney respectfully submitted that the amendments were not necessary for the reasons set forth above, and as further detailed in Section II below.

II. Reply

The Applicant requests that the rejections in the second Office Action be withdrawn for failure to comply with MPEP §§ 707.07(f) and 2143. In particular, the Applicant submits that both the first and second Office Actions fail to address elements in each of the independent claims and thus fail to make out a *prima facie* case of obviousness under MPEP § 2143. Additionally, the second Office Action fails to address numerous arguments the Applicant presented in the reply filed on June 14, 2004, and thus the second Office Action fails to comply with MPEP § 707.07(f). For these reasons, the Applicant requests that the Examiner must either (1) allow the pending claims, or (2) provide a new, non-final Office Action with new grounds of rejection. Considering that the instant case has been pending since August 8, 2001, and two Office Actions have issued, the Applicant's attorney respectfully submits that the proper course of action is to issue a notice of allowance. See MPEP § 707.02.

A. Withdrawal of Rejections for Failure to Comply with MPEP § 2143.03

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added); MPEP § 2143.03

i. The limitation “associated with each corresponding recipient account” was not considered in either Office Action

Independent claims 1, 11 and 20 include the limitation “....so that each recipient data set includes only data sets associated with each corresponding recipient account.” The highlighted limitation “associated with each corresponding recipient account” has

never been addressed in either Office Action (see the bottom of page 3 of both the first and second Office Actions). The rejections address only recipient data sets including “only data sets”, but never go on to address the limitation “associated with each corresponding recipient account.” The Applicant specifically pointed this out in the reply filed on June 14 (see pages 14-15 of that reply). The second Office Action does not even acknowledge the failure to address this limitation, and rejects claims 1, 11 and 20 by merely repeating the rejection of the first Office Action. This is clearly an improper rejection as it fails to meet the requirements of MPEP § 2143.03, i.e., the rejection fails to show how all the claims limitations are met by Sherman and Waskiewicz. Both the first and the second Office Actions completely ignore these words in the claims and thus fail to establish a prima facie case of obviousness under MPEP § 2143.03.

For this reason, the rejection of claims 1, 11 and 20, and all claims depending therefrom, must be withdrawn. Additionally, because this limitation has never been addressed in either the first or second Office Action, the next Office Action (should the claims not be allowed) must necessarily raise new grounds of rejections not necessitated by an Applicant’s amendment nor based on information submitted in an information disclosure statement. Accordingly, under MPEP § 706.07(a), the next Office Action must be non-final.

ii. “transaction file”

Claim 26 recites “a transaction file stored on the computer storage medium, the transaction file storing a transaction history of the distribution of data sets.” The second Office Action states on page 9 that the graphics file disclosed in Sherman meets this limitation, stating:

With respect to claim 26, Sherman discloses further comprising a transaction file stored on the computer storage medium, the transaction file storing a transaction history of the distribution of data sets (attachments such as graphic files: col. 7, lines 1-12).

The above passage is the totality of the rejection with respect to the transaction file, and was also repeated in the second Office Action. The recited passage in Sherman, however, merely states that the message may include text, graphics, or other files. As the Applicant argued in the June 14 reply, a “graphics file” is not a “transaction file storing a

transaction history of the distribution of data sets.” In fact, nothing in Sherman teaches or suggests a transaction history file storing a transaction history of the distribution of data sets. Both the first and the second Office Actions do not show how a graphics file could be modified to teach this limitation, nor do the Office Actions show how the art provides a suggestion or motivation for such modification. Thus, the Office Actions do not show how the prior art reference (or references when combined) teach or suggest this claim limitation. Clearly, this claim limitation has not been shown by Sherman either alone or in combination with any other art.

For this additional reason, the rejection must be withdrawn, and the claims must either be allowed or a new, non-final action should be issued.

iii. **“distribution control file”**

Claims 22-25 include the limitation

further comprising a distribution control file stored on the computer storage medium, the distribution control file storing the association of data sets to selected classes and selected recipient accounts.

On page 18 of the Applicant’s June 14 reply, the Applicant points out that this limitation is not addressed in the first Office Action. For this additional reason, the rejection must be withdrawn, and the claims must either be allowed or a new, non-final action should be issued.

B. Withdrawal for Failure to Comply with MPEP § 707.07(f)

The second Office Action responds to only two of multiple separate arguments presented by the Applicant. In particular, the Applicant traversed the rejections in the first Office Action on at least the following grounds:

- 1) Sherman teaches away from claims 1, 11, and 20;
 - 2) Sherman teaches away from claims 35 and 46;
 - 3) Sherman and Waskiewicz, when combined, do not teach a “recipient data set” as claimed in claims 1, 11, and 20;

- 4) Sherman and Waskiewicz, when combined, do not teach “creating a data set for each recipient in the class, wherein only the data set corresponding to the one recipient includes the second file,” as claimed in claims 35 and 46;
- 5) Not all of the limitations of each element was addressed in the rejection of claims 1, 11, and 20 (“associated with each corresponding recipient account”);
- 6) Sherman and Waskiewicz cannot be shown to teach all of the claimed limitations of claims 1, 11, and 20;
- 7) Sherman and Waskiewicz do not teach a transaction file;
- 8) Sherman and Waskiewicz and Reed do not teach a distribution control file; and
- 9) The language of numerous dependent claims is not addressed.

The second Office Action replied to the Applicant’s arguments by stating 1) Sherman’s attached files such as text or graphics files are data sets in light of the specification of the application; and 2) Sherman’s Figs. 8A and 8B, which shows an e-mail hierarchy, meets the limitation of “creating a data set for each recipient in the class...to the one recipient includes the second files.”

The second Office Action, however, failed to address all of the remaining arguments presented by the Applicant - 1) Sherman teaches away from claims 1, 11, and 20; 2) Sherman teaches away from claims 35 and 46; 5) Not all of the limitations of each element was addressed in the rejection of claims 1, 11, and 20 (“associated with each corresponding recipient account”); 6) Sherman and Waskiewicz cannot be shown to teach all of the claimed limitations of claims 1, 11, and 20; 7) Sherman and Waskiewicz do not teach a transaction file; 8) Sherman and Waskiewicz and Reed do not teach a distribution control file; and 9) The language of numerous dependent claims is not addressed.

i. **The second Office Action failed to rebut the Applicant’s argument that Sherman teaches away from the claimed invention**

The Applicant respectfully submits that the rejection of all claims must be withdrawn because the second Office Action does not rebut the Applicant’s argument that

Sherman teaches away from the claimed invention of claims 1, 11, 20, 35 and 46. As fully set forth in the reply filed on June 14, 2004, the Applicant explained that Sherman defined synchronization as involving “an electronic comparison and correlation of data between the companion device and the primary computer (such as a server or personal computer) to maintain data uniformity on both systems.” The claimed inventions of claims 1, 11, 20, 35 and 46, however, include only data associated with each corresponding recipient account.¹ Clearly, data sets that only include data associated with each corresponding recipient account are not uniform data sets. Thus, Sherman teaches a system that creates data uniformity between a first computer system and a second computer system. Conversely, claims 1, 11, 20, 35 and 46 claim systems or methods for creating unique recipient data sets for each recipient and that are to be distributed to the recipients. Therefore, because Sherman teaches away from these independent claims, the Applicant respectfully submitted that the rejections were improper and requested that the rejection of claims 1, 11, 20, 35 and 46, and all claims depending therefrom, be withdrawn. The second Office Action completely ignored this clear rebuttal of obviousness presented by the Applicant, and thus the Applicant’s rebuttal of obviousness stands.² Accordingly, the rejection of claims 1, 11, 20, 35 and 46, and all claims depending therefrom, must be withdrawn.

ii. The Remainder of the Applicant’s Arguments Were Also Ignored

The second Office Action also failed to address numerous arguments the Applicant presented in the reply filed on June 14, 2004. Accordingly, the second Office Action fails to comply with MPEP § 707.07(f).³ For this additional reason, the rejections

¹ See June 14, 2004 reply, pp. 12-14 and 20-22.

² Technically, there is no case of obviousness to rebut, as the first and second Office Actions did not establish obviousness of the independent claims. See Section II.A. of this reply. Accordingly, the presentation of the Applicant’s argument that Sherman teaches away is not to be construed as an admission that a *prima facie* case of obviousness was actually established.

³ Additionally, in replying to the Applicant’s arguments, the second Office Action again ignores the claim language of “associated with each corresponding recipient account.”

should be withdrawn.

C. Protracted Prosecution

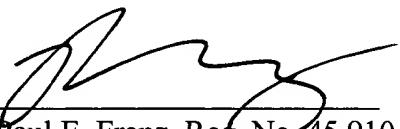
The instant case has been pending since August 8, 2001, and has had two Office Actions issued. In response to each Office Action, the Applicant has clearly shown how the pending claims are allowable over the cited art. Accordingly, the instant application must either be allowed or become subject to a third, non-final Office Action. The Applicant respectfully submits that the proper course of action is to issue a notice of allowance and bring prosecution to a close. See MPEP §707.02.

III. Conclusion

For the reasons set forth in the reply of June 14, 2004, and for the reasons set forth herein, the Applicant's attorney respectfully submits that the claims have not been shown to be obvious over the prior art of record and are thus allowable over the cited art of record. The Applicant therefore requests that the rejections of the final Office Action be withdrawn and that a notice of allowance be issued.

Should the Examiner not issue a notice of allowance, then the Applicant submits that the Examiner must provide new grounds for rejection and issue a new, non-final Office Action.

Respectfully submitted,



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language, and thus fails once again to establish a prima facie case of obviousness under MPEP § 2143.03.

DRAWING AMENDMENTS

The attached drawing sheets 1-23 are formal versions of the previously submitted informal drawing sheets 1-23. For the reasons set forth in the remarks section below, the Applicant's attorney respectfully submits that prosecution must be reopened to either allow the pending claims or to issue a third, non-final Office Action. Accordingly, acceptance of the formal drawings after final is requested.

Attachment: Replacement sheets 1-23.